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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,817	12/05/2003	Katsuaki Akama	FUJS 20. 759	2105

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KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

EXAMINER
HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/729,817	AKAMA, KATSUAKI
	Examiner	Art Unit	
	Calvin L. Hewitt II	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 May 1107</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-16</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-16</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>12-5-03</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Status of Claims

1.   Claims 1-16 have been examined.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "requesting said coupon issuance/management server to issue said electronic coupon" from an information terminal. However, the claim also recites "when issuance/management server the issue request" therefore it is unclear to one skill whether or not the server actually receives the request (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). For example, it is not clear if the request from the terminal goes through an authentication, validation or filtering process, and if the request fails any of these processes, then the server does not receive the request.

Claims 2-16 are also rejected as each depends from claim 1.

Claim 5 is directed to a server that affixes an electronic signature on a value and owner identification information. However, to one of ordinary skill it is unclear whether or not Applicant is putting a signature physically on top of (i.e. affixing) the pecuniary value or creating a digital signature by hashing and then encrypting the hash result (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claim 15 recites storing an electronic coupon in an IC card. However, claim 13, from which claim 15 depends, recite storing the coupon in terminal side memory. Therefore, to one of ordinary skill it is unclear where the coupon is stored; on a terminal hard drive, an IC card or both.

For purposes of examination, the Examiner is interpreting claim 15 as follows: storing the electronic coupon in terminal-side memory

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al., U.S. Patent No. 5,855,007 in view of Laor, U.S. Patent No. 6,076,069.

As per claims 1-16, Jovicic et al. teach an electronic transaction method comprising:

- requesting an electronic coupon from a coupon server and the server transmitting the coupon comprising a value and a customer name (figure 3; column/line 6/49-7/40) to the requesting device (column 7, lines 40-45; column/line 7/55-8/17)

- a customer database and recording and managing coupon owner (e.g. customer) information (figure 1, items 124 and 126; column 6, lines 3-14; column 9, lines 10-26)

- a redemption server changing owner information according to a transferee apparatus of said coupon (figure 4, item 422; column 7, lines 45-50; column 9, lines 23-28; column/line 10/63-11/4)

- the customer transferring the coupon to a shop (column 7, lines 45-50) and also notifying the [redemption] server of the transfer (column/line 1/60-2/2; column 2, lines 30-35; column 7, lines 52-55)

- setting a validity term for the coupon (figure 3, item 314; column 7, lines 9-11)

- managing the status of the electronic coupon (figure 1, items 124 and 134; column 9, lines 10-40; column/line 10/45-11/37)

- [periodically) charging a user an amount corresponding to the coupon's

  value (figure 3, items 302 and 308; column 2, lines 25-30; column/line

  6/65-7/2; column 11, lines 38-41)

However, Jovicic et al. do not specifically recite a server that records coupon

owner information and also changes owner information according to a transferee

apparatus. Laor teaches a single server that both transmits an electronic coupon

to a user in response to a user request and redeems, as well as authenticates,

the electronic coupon (column 4, lines 50-67). Laor also teaches a server

receiving a coupon from a user and modifying or enabling a transaction using

said coupon (column/line 4/50-5/5). Therefore, it would have been obvious to one

of ordinary skill to combine the teachings of Jovicic et al. and Laor (*In re Wolfe*,

116 USPQ 443, 444 (CCPA 1961)).

As per claims 5-7, Jovicic et al. teach an electronic coupon that includes a

value (figure 3, items 302 and 308; column/line 6/59-7/2) and an owner

identification number (figure 3, items 320 and 322). Laor teaches a unique key

that can be used to validate or authenticate the coupon (column 4, lines 7-10). A

remote server that stores a user signing key and signs data on behalf of the user

using said key is old and well known. Further, to one of ordinary skill a unique

key for authenticating and validating data is a signing key wherein the signing

key is a private key of a public/private key pair. Regarding multiple keys, it has

been held that an obvious modification of Laor is to use multiple keys to sign

multiple data as the duplication of parts has no patentable significance unless

new and unexpected result is produced (*In re Harza*, 124 USPQ 378 (CCPA

1960)). It has also been held that the mere arrangement of data in memory (i.e.

where the signature is found in the electronic coupon) will not distinguish the

claims from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re*

Ngai, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir.

1994); MPEP 2106.01).

As per claim 7, Jovicic et al. teach transferring the electronic coupon from

a transferee apparatus to the server for authentication (column 7, lines 50-55).

More specifically, the prior art teaches conveying the results to the transferee

apparatus and the information terminal (column 2, lines 25-30; column 7, lines

50-55; column 11, lines 12-20), and redeeming a coupon (or changing the owner

of the coupon) (column/line 10/62-11/3) based on the authentication process

(Note: Method steps that do not have to be performed to do not limit the scope of

the claim or the limitation-MPEP §2106 II C).

As per claim 12, Jovicic et al. teach charging a user an amount

corresponding to the coupon's value (figure 3, items 302 and 308; column 2,

lines 25-30; column/line 6/65-7/2; column 11, lines 38-41), regarding what

conditional or optional language, method steps that do not have to be performed

to do not limit the scope of the claim or the limitation (*Intel Corp. v. Int'l Trade*

Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991) MPEP §2106 II C).

As per claims 13-16, Jovicic et al. teach storing an electronic coupon on an information terminal (figure 2, item 218 and figure 4; column 8, lines 10-32) wherein said terminal comprises a display means (figure 2, items 214 and 218; column 8, lines 18-32). Information terminals that require a user to provide a username and password in order to access the terminal are old and well known.
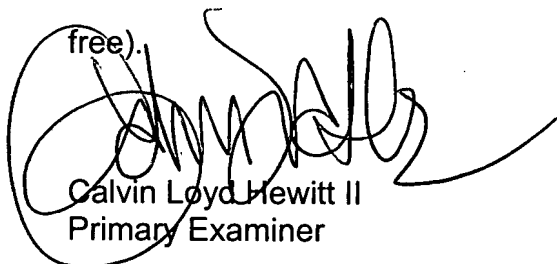
Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Vollert teaches a server that stores a user private key and signs data on behalf of the user using the key

- Yamashita teaches applying an electronic signature to an electronic coupon and authenticates the coupon using the signature

- Palmer et al. teach digitally signing coupons and a user storing a coupon received over the internet in a smart card

- Kung teaches logging onto a computer using a username and password

7.   Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (571) 272-6709. The Examiner can normally be reached on Monday-

Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the

Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see **http://pair-**

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

Calvin Loyd Hewitt II
Primary Examiner

July 22, 2007